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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Haynes *et al.*

Group Art Unit: 3625

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Examiner: Garg, Yogesh C.

Serial No.: 09/845,362

Title: METHOD FOR MANAGING AN ELECTRONIC -COMMERCE SHOPPING
CART

Commissioner for Patents
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REPLY BRIEF OF APPELLANT

This Reply Brief addresses issues in the Examiner's Answer mailed September 14,

09/845,362

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GROUND OF REJECTION 1

Claims 1-4, 14-22 and 24-28 stand rejected under 35 U.S.C. §102(e) as allegedly being unpatentable over Henson et al.

Claims 1, 17-19, and 27-28

Appellants respectfully contend that claims 1 and 19 are not anticipated by Henson, because Henson does not teach each and every feature of claims 1 and 19. For example, Henson does not teach or suggest the feature: "after the server has determined that the shopping command has changed the attribute of the primary item in the shopping cart, identifying by the server a **secondary item in the shopping cart** linked to the primary item; and changing by the server a corresponding attribute of the secondary item in response to the change in the attribute of the primary item" (emphasis added).

Appellants contend that the term "shopping cart" in claims 1 and 19 is specific to the shopper, and the primary item and secondary item have been placed in the shopping cart as a consequence of the primary and secondary items having been previously selected for placement in the shopping cart. As an example, see FIG. 2 of Appellants' specification, and description thereof on page 6, lines 6-12 beginning with the sentence: "The shopper 100 uses shopping commands to assemble a shopping cart 200 of items to be purchased from the merchant 130, as shown in FIG. 2, adding items to the shopping cart 200, changing items in the shopping cart 200, and removing items from the shopping cart 200." The preceding interpretation of "shopping cart" not only reflects Appellants' specification, but also reflects the meaning of "shopping cart" as conventionally used in e-commerce on the Internet.

A key issue under dispute between Appellants and the Examiner's Answer is whether Henson teaches the limitations in claims 1 and 19 relating to "a secondary item in the shopping cart". Based on the aforementioned meaning of "shopping cart", Appellants maintain that the language of claims 1 and 19 requires the secondary item to be in the shopper's shopping cart before the "identifying" and "changing" steps of claims 1 and 19 are performed.

In contrast, at the time when Henson's configurator presents the shopper with a menu of secondary options (after the shopper selected a "different" primary item), there is no teaching in Henson that the secondary items in the menu are already in the shopper's shopping cart. The only way that a secondary item in Henson can be in the shopping cart is for the shopper to select the secondary item. In fact, when Henson's configurator presents the shopper with a menu of secondary options, there is no teaching in Henson that the shopper had previously selected ANY secondary item for placement in the shopping cart. Therefore, Henson does not anticipate claims 1 and 19.

The Examiner's Answer argues that Henson, col. 15, lines 31-45 teaches the preceding feature of claims 1 and 19.

Appellants respectfully contend that Henson, col. 15, lines 31-45 does not teach the preceding feature of claims 1 and 19. In particular, Henson, col. 15, lines 31-44 recites: "Everything in the configurator is specific to a given computer system (i.e., chassis) per customer or per set of customers. The welcome page is geared towards identifying a chassis. Given the chassis, the configurator displays the universe or possible options within that chassis, for a given customer set. Messaging has now been included in that option universe to assist a user in choosing a best selection for that user. If a user decides upon a different chassis, the user must

return to the welcome page and select another chassis. The options within the configurator are dependent upon the chassis. If a user wants to go to a different universe, then the user must exit the configurator, go back to the welcome page, and select a new universe (i.e., a different chassis)."

In the preceding quote from Henson, the Examiner's Answer alleges that a chassis is a primary item in the shopping cart of the user, and by deciding upon a different chassis the user has changed an attribute of the chassis. Henson col. 15, lines 31-44 does not disclose "identifying by the server a secondary item in the shopping cart linked to the primary item". In other words, Henson col. 15, lines 31-44 does not disclose the existence of any secondary item in the user's shopping cart that is linked to the originally selected chassis. The Examiner's Answer argues that the options presented to the user after the user has selected a different chassis are secondary items. However, these menu items presented to the user **are not in the user's shopping cart**, as required by claims 1 and 19.

In other words, claims 1 and 19 require that the server change an attribute of a secondary item in the shopping cart in response to a change in the primary item that **is also in the shopping cart**. The argument in the Examiner's Answer has totally disregarded the requirement in claims 1 and 19 that both the primary item and its linked secondary item must be **in the shopping cart** before the user changes an attribute of the primary item, and therefore before the server changes a corresponding attribute of the secondary item. Henson simply does not teach "identifying by the server a secondary item **in the shopping cart** linked to the primary item".

In addition, what happens in claims 1 and 19 is that a secondary item is first in the shopping cart and then its attribute is changed (in response to the change in the attribute of the

primary item). The idea behind claims 1 and 19 is that once the user changes an attribute of the primary item in the shopping cart, the user is relieved of the burden of changing a corresponding attribute of the secondary item **in the shopping cart**. The work of changing the corresponding item of the secondary item in the shopping cart is instead done by the server. The language of claims 1 and 19 captures this idea.

In contrast, Henson's server never changes an attribute of a secondary item in the user's shopping cart. All that Henson's server does is to present a menu of options to the user and forces the user to change the attribute of a secondary item by making a selection from the menu. Henson's server simply does not do the job required of it in claims 1 and 19, namely to actually change the attribute of the secondary item **in the shopping cart**. Again, Henson's server doesn't want to be bothered to make this change and instead forces the user to make this change by presenting a menu of options to the user and telling the user to make a selection. The user's selection from the menu is what changes the attribute of the secondary item in the shopping cart.

In "Response to Arguments", the Examiner's Answer argues: "Whenever a users shopping command is received by the on-line store "10" its server allows the user to change the computer system by allowing him to select a new primary system on the welcome page and then presents the changed primary item, that is the computer system with its specific add-on options [secondary items]. Changing the computer system requirement by the user corresponds to the shopping command from the user for changing an attribute of the primary item [the computer system which the user wants to buy]. Therefore, Henson suggests that the attributes of the secondary item are changed by the server automatically in response to determining a change in

the primary item. For example, Figs. 3A-3C demonstrate configuration for a primary item, that is a desk top computer system model XPSR and if the user wants to change to another desktop Dell Model or a Laptop computer the server on the on-line store 10 server will change the attributes of the add-on options [secondary items] specific to the changed Dell desktop model or a laptop computer system."

In response, Appellants contend that the preceding argument in "Response to Arguments" of the Examiner's Answer has not provided any evidence that the secondary items of the add-on options associated with computer system model XPSR are in the shopping cart, as required by claims 1 and 19.

In "Response to Arguments", the Examiner's Answer additionally argues: "It is already analyzed above that the software, Commerce Application "14" in Henson comprising configuration and a cart does change the attributes of the secondary items to be specific to the changed primary item with the change in primary item and the function or presenting menu of the secondary items further helps the on-line store server to request authorization for the changed secondary items when the user indicates his authorization by selecting the secondary items as per his choice."

In response, Appellants contend that the preceding argument in "Response to Arguments" of the Examiner's Answer has not provided any evidence that the secondary items specific to the changed primary item are in the shopping cart, as required by claims 1 and 19.

Based on the preceding arguments, Appellants respectfully maintain that Henson does not

anticipate claims 1 and 19, and that claims 1 and 19 are in condition for allowance. Since claims 17-18 depend from claim 1, Appellants contend that claims 17-18 are likewise in condition for allowance. Since claims 27-28 depend from claim 19, Appellants contend that claims 27-28 are likewise in condition for allowance.

Claims 14 and 24

Since claims 14 and 24 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be anticipated by Henson, Appellants maintain that claims 14 and 24 are likewise not anticipated by Henson.

In addition with respect to claims 14 and 24, Henson does not teach the feature: "ascertaining whether the primary item is a new primary item; and after said ascertaining has ascertained that the primary item is not said new primary item, then performing said identifying step".

The Examiner's Answer argues that Henson, col. 15, lines 31-45 teaches the preceding feature of claims 14 and 24.

In response, Appellants note that Henson, col. 15, lines 31-45 recites: "Everything in the configurator is specific to a given computer system (i.e., chassis) per customer or per set of customers. The welcome page is geared towards identifying a chassis. Given the chassis, the configurator displays the universe of possible options within that chassis, for a given customer set. Messaging has now been included in that option universe to assist a user in choosing a best selection for that user. If a user decides upon a different chassis, the user must return to the welcome page and select another chassis. The options within the configurator are dependent

upon the chassis. If a user wants to go to a different universe, then the user must exit the configurator, go back to the welcome page, and select a new universe (i.e., a different chassis). Recommendations can include lead time warnings, as well as compatibility warnings.”.

Appellants respectfully contend that the preceding quote in Henson, col. 15, lines 31-45 does not teach “ascertaining whether the primary item is a **new primary item**” as required by claims 14 and 24.

Moreover, Henson, col. 15, lines 31-45 does not teach “after said ascertaining has ascertained that the primary item is not said new primary item, then performing said identifying step”. Instead, Henson, col. 15, lines 31-45 teaches displaying the universe of possible options within a **different chassis**.

Accordingly, Appellants contend that claims 14 and 24 are not anticipated by Henson.

Claims 15 and 25

Since claims 15 and 25 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be anticipated by Henson, Appellants maintain that claims 15 and 25 are likewise not anticipated by Henson.

In addition with respect to claims 15 and 25, Henson does not teach the feature: “wherein the attribute of the primary item and the corresponding attribute of the secondary item are a same attribute”.

In “Response to Arguments”, the Examiner’s Answer argues: “Henson’s invention does teach that both the primary item [the computer system] and the secondary items [add-on options] have a long lead time warning and which is a common attribute for both the primary and

secondary item, see col.6, lines 44-67.”

In response, Appellants contend that the only relevant text of Henson, col.6, lines 44-67 is: “The warning icon is presented to the online shopper upon the selection of a system option that has been identified as having a significant impact on the time to delivery of the system of interest”. Appellants contend that the preceding quote from Henson does not teach that primary item [the computer system] and the secondary items [add-on options] in the shopping cart both have the same attribute of long lead time.

Accordingly, Appellants contend that claims 15 and 25 are not anticipated by Henson.

GROUND OF REJECTION 2

Claims 13 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619).

The Examiner's Answer rejected claims 13 and 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619).

Since claims 13 and 23 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be unpatentable over Henson under 35 U.S.C. §102(c), Appellants maintain that claims 13 and 23 are likewise not unpatentable over Henson in view of Chandramohan under 35 U.S.C. §103(a).

In addition, with respect to claims 13 and 20, Henson in view of Chandramohan does not teach the feature: "wherein before said determining step, said method further comprising the step of: waiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server".

The Examiner's Answer argues: "Chandramohan discloses the step of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server (see at least col.7, line 27-col.8, line 12," FIG. 3A is a timing diagram that illustrates the method and operation of the present embodiment. As a background activity, the a-serve server module 101 monitors the network 146 (as shown in FIG. 1A) and waits for requests from a-serve client modules 103, as shown in element 306"). In view of Chandramohan, it would have been

~~obvious to one of an ordinary skill in the art~~ at the time of the applicant's invention to have incorporated the feature of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server because it is well-known that the Transmission Control Protocol/Internet Protocol (TCP/IP) is a 'common networking protocol used for communication among computer-systems 100 that allows uniform formatting of data for transmittal and receipt and enabling the e-server to communicate with the client modules.'".

In response, Appellants respectfully contend that the argument in the Examiner's Answer for modifying Henson by the alleged teaching of Chandramohan is not persuasive

A first reason why the argument in the Examiner's Answer for modifying Henson by the alleged teaching of Chandramohan is not persuasive is that the Examiner's citation of Chandramohan describes the e-server module waiting for requests from e-server client modules, which is not equivalent to waiting for a shopping request as is required in claims 13 and 20.

In "Response to Arguments", the Examiner's Answer argues: "The invention of Chandramohan is related to a method, system and apparatus for distributing computer related services, such as computer based applications over a network which teaches that the server responds to the inputs received from a user interface and is thus in the same field of endeavor that is of Henson which is related to providing services of selling computer and computer related items/services in response to the inputs received from a user and therefore in view of the teachings of Chandramohan, it would be obvious to one of an ordinary skill in the art to understand and imply the teachings that the server in Henson waits *for* a shopping command and continues to wait by for said shopping command so long as said shopping command has not been

received by the server to initiate further step of presenting the new primary item along with new attributes of secondary item."

In response, Appellants contend that the preceding argument in "Response to Arguments" is not persuasive because the Examiner's Answer is incorrectly assuming that waiting for requests from c-server client modules as taught by Chandramohan makes it obvious to wait by for a shopping command from a user. Appellants contend that a shopping command from a user is not sufficiently analogous to an c-server client module to warrant the allegation of obviousness in the Examiner's Answer.

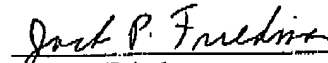
A second reason why the argument in the Examiner's Answer for modifying Henson by the alleged teaching of Chandramohan is not persuasive is that modifying Henson because "(TCP/IP) is a common networking protocol used for communication among computer-systems" seems illogical as a reason for modifying Henson. In fact, Chandramohan discussion of TCP/IP in col. 7, lines 39-46 does not relate the use of TCP/IP as motivation for the c-server module waiting for requests from c-serve client modules in col. 7, lines 28-31.

Accordingly, Appellants maintain that the Examiner's Answer has failed to establish a *prima facie* case of obviousness in relation to claims 13 and 23.

SUMMARY

In summary, Appellant respectfully requests reversal of the January 11, 2005 Office Action rejection of claims 1-4 and 13-28.

Respectfully submitted,



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